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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,939	12/17/2001	Prakash Kadkade	31699.0086	2933
21967	7590	12/16/2003	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			WARE, DEBORAH K	
			ART UNIT	PAPER NUMBER
			1651	6
DATE MAILED: 12/16/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

10/015,939

Applicant(s)

KADKADE, PRAKASH

Examiner

Deborah K. Ware

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,22,23,25 and 61-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,22,23,25 and 61-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claims 1-8, 22-23, 25 and 61-74 are pending.

The instant application is a Continuation of 09/307,787 filed May 10, 1999, now abandoned, which is a Continuation of 08/659,997 filed June 7, 1996, now U. S. Patent No. 6,127,181, which is a Continuation-In-Part of 08/486,204 filed June 7, 1995, now U.S. Patent No. 5,965, 438. Applicants are invited to please amend the instantly filed specification at page 1, line 1, to indicate the current status of the above noted continuing data. Note that the above priority status in the specification is necessary in order that appropriate priority may be afforded to Applicants.

The notification of change in small entity status filed July 8, 2003, is noted. Also Applicants' response to Notice to file missing parts is noted, as well. Furthermore, the Preliminary Amendment filed June 7, 2002, has been received and entered. Cancellation of claims 20-21 and 27-60 are noted.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 22-23, 25 and 61-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rendered vague and indefinite for "by warming by heating" recited at line 3, because the phrase is considered redundant as to the double meaning suggested. It is suggested to delete "by warming" because the phrase is superfluous.

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Also "the freezing point" recited at line 4, lacks antecedent basis. Further, "a media" as recited in line 5, is unclear as to how many different mediums are intended, or perhaps this is a typo because "a" is used before "media" which is grammatically indefinite since "a" infers a single medium, per se. It is suggested to change "media" to --medium--.

Further, the phrase recited as "removing any osmotic or cryoprotective agent, if present," renders the claims indefinite because the incubating step of claim 1 clearly requires at least one cryoprotective agent and a stabilizer, not any osmotic agent. Also "if present" is vague as to when would such case occur for the claimed method, per se.

Claim 3 is further rendered vague and indefinite since the term "genus" is omitted from the claim and it is suggested that the term be inserted after "of" on line 2. Claims 6-7 are further rendered vague and indefinite for "the genus" at line 2, which lacks antecedent basis and should change "the" to --a--. Claim 8 is further rendered vague and indefinite for lacking antecedent basis for the recitation of "the mixture" at line 2. Also what is intended by the term/phrase "pelleting of the cells"? Claim 64 better defines this language. However, it remains unclear at what point an osmotic agent is added in the method? The metes and bounds of the claims are unclear. Claim 63 is further rendered vague and indefinite in that it is unclear in what step pretreatment is carried out? Perhaps the incubating step? Therefore, the metes and bounds of the claims can not be determined for this reason as well. Claim 66 is unclear for the use of the abbreviation "M" which is unclear as to whether the intended meaning is moles, or what? Use of abbreviations in the claims is not suggested. Applicants are invited to point out in the specification wherein the abbreviation is defined as M, per se and this

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will be sufficient, no change would then be necessary. Claim 67 is unclear with respect to whether each cell has the agent present in that concentration, since there is more than one cryopreserved cell but the claim 67 only refers to a single cell. Explanation requested or to pluralize the term and change "has" to "have". Also claims 69 and 70 are unclear for the same reason as discussed above for claim 67 with respect to one cell or cells intended by the claimed subject matter. Throughout the claims more than one cell is referred to, see claim 1.

Claims 22-23 and 25 and 71-74 are rendered vague and indefinite for the recitation of "the freezing point" at lines 3-4 of claim 22. Also "in a media" renders the claims indefinite for the same reasons discussed above for claim 1.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-8, 22-23, 25 and 61-74 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-28 of U.S. Patent No. 6,127,181. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant case only differ from the patented claims in that the obtaining the cryopreserved plant cells does not required the claimed cryopreserving method of patented claim 1, per se. Any cryopreserving method may be used per se to obtain the crypreserved cells. It would have been obvious to one of ordinary skill in the art to select for any method of cryopreservation of the art to obtain cryopreserved plant cells. Clearly one of skill would have expected successful results by thawing the cryopreseved plant cells and incubating them in a medium and recovering the plant cells. Hence, the claims of the patent would have made obvious the claims of the instantly filed case

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 308-4245. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 308-4743. The fax phone number for the organization where this application or proceeding is assigned is 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0196.



DEBORAH K. WARE
PATENT EXAMINER

Deborah K. Ware
November 18, 2003